



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,363	05/29/2001	Chidambaram Krishnan	010094	5659

23696 7590 12/07/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,363

Applicant(s)

KRISHNAN ET AL.

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-72 are pending in the application.
2. Claims 1-72 have been rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-5, 7-9, 11-13, 16-21, 23-25, 27-29, 32-37, 39-41, 43-45, 48-53, 56-61, 64-69 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohrbach U.S. Patent No. 5,898,783.**

As to claims 1, 17 and 33, Rohrbach discloses a method for controlling power to a subscriber identity module (SIM) in a wireless communication device (WCD), the method comprising:

supplying power to the SIM when a request is pending for service by the SIM [column 3 line 62 to column 4 line 12];

supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM [column 4, lines 13-37]; and

terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM [column 4, lines 38-45].

Art Unit: 2131

As to claims 2, 18 and 34, Rohrbach discloses re-initiating supply of power to the SIM following termination of power to the SIM when a request from the WCD is pending for service by the SIM [column 4 line 55 to column 5 line 4].

As to claims 3, 19 and 35, Rohrbach discloses determining whether a request from the WCD is pending for service by the SIM by inspecting a request queue associated with the SIM [column 3 line 62 to column 4 line 12].

As to claims 4, 20 and 36, Rohrbach discloses re-initiating supply of power to the SIM when a software module running on the WCD requests supply of power to the SIM [column 4 line 55 to column 5 line 4].

As to claims 5, 21 and 37, , Rohrbach discloses determining whether a software module running on the WCD requests supply of power to the SIM by polling any of a plurality of software modules running on the WCD [column 5, lines 13-31].

As to claims 7, 23 and 39, Rohrbach discloses supplying power to the SIM includes maintaining power to the SIM [column 4 line 55 to column 5 line 4].

As to claims 8, 24 and 40, Rohrbach discloses that the SIM includes an interface circuit that interfaces with the WCD, and terminating power to the SIM includes terminating power to the interface circuit [column 4, lines 13-25].

As to claims 9, 25 and 41, Rohrbach discloses that the SIM includes a power supply line coupled to the WCD, and terminating power to the SIM includes terminating power to the power supply line [column 4, lines 38-45].

As to claims 11 and 27, Rohrbach discloses the method further comprising:

Art Unit: 2131

storing a user access code associated with the SIM in a memory associated with the WCD [column 5, lines 13-31];

retrieving the user access code from the memory when power is supplied to the SIM following the termination of power to the SIM [column 5, lines 13-31]; and

using the retrieved user access code in a security authorization process to authorize use of secure features of the SIM [column 3 line 62 to column 4 line 12].

As to claims 12, 28 and 44, Rohrbach discloses storing the user access code includes storing the user access code upon the termination of power to the SIM [column 5, lines 13-31].

As to claims 13, 29, 45, 53, 61 and 69, Rohrbach discloses that the SIM is one of a removable user identification module (R-UIM) [column 3 line 62 to column 4 line 3] and a GSM SIM [column 1, lines 14-28], and the user access code is a card holder verification (CHV) code [column 3 line 62 to column 4 line 3].

As to claims 16, 32, 48, 56, 64 and 72, Rohrbach discloses that the WCD is one of a cellular radiotelephone, a satellite radiotelephone, a PCMCIA card, and a PDA that communicates according to one of the CDMA standard, the GSM standard, and the WCDMA standard [column 3 line 62 to column 4 line 3].

As to claim 43, Rohrbach discloses the instructions cause the processor to:

store a user access code associated with the SIM in a memory associated with the WCD [column 5, lines 13-31];

Art Unit: 2131

retrieve the user access code from the memory when power is supplied to the SIM following the termination of power to the SIM [column 5, lines 13-31]; and

use the retrieved user access code in a security authorization process to authorize use of the WCD [column 3 line 62 to column 4 line 12].

As to claims 49, 57 and 65, Rohrbach discloses a method comprising:

storing a user access code associated with a subscriber identity module (SIM) in a memory associated with a wireless communication device (WCD) [column 5, lines 13-31];

retrieving the user access code from the memory when power is resupplied to the SIM [column 4, lines 13-26]; and

using the retrieved user access code in a security authorization process to authorize use of secure features of the SIM [column 3 line 62 to column 4 line 3].

As to claims 50, 58 and 66, Rohrbach discloses the method further comprising:

terminating power to the SIM when no request from the WCD is pending for service by the SIM and no software module running on the WCD requests supply of power to the SIM [column 4 line 55 to column 5 line 4]; and

terminating power to the SIM when power to the WCD is terminated [column 4 line 55 to column 5 line 4].

As to claims 51, 59 and 67, Rohrbach discloses the method further comprising:

retrieving and using the user access code when power is resupplied to the SIM following termination when no request from the WCD is pending for service

Art Unit: 2131

by the SIM and no software module running on the WCD requests supply of power to the SIM [column 4, lines 13-26]; and

accepting and using user input as the user access code when power is resupplied to the SIM following termination when power to the WCD is terminated [column 4 line 55 to column 5 line 4].

As to claims 52, 60 and 68, Rohrbach discloses storing the user access code includes storing the user access code when power to the SIM is terminated [column 5, lines 13-31].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 22 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach U.S. Patent No. 5,898,783 as applied to claims 1, 17 and 33 above, and further in view of Deschepper et al U.S. Patent No. 6,741,848 B2.

As to claims 6, 22 and 38, Rohrbach does not teach asserting respective bits in a data structure when corresponding software modules running on the WCD request supply of power to the SIM. Rohrbach does not teach determining whether a software module running on the WCD requests supply of power to the SIM by analyzing the data structure. Rohrbach does not teach when any of the bits in the data structure is asserted, supplying power to the SIM.

Deschepper et al teaches asserting respective bits in a data structure [column 3, lines 3-20]. Deschepper et al teaches analyzing the data structure [column 3, lines 21-32].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach so that respective bits in a data structure would have been asserted when corresponding software modules running on the WCD requested supply of power to the SIM. It would have been determined whether a software module running on the WCD requested supply of power to the SIM by analyzing the data structure. When any of the bits in the data structure were asserted, power would have been supplied to the SIM.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach by the teaching of Deschepper et al because it continues to increase computer system functionality as user needs evolve, modifications to existing components can be prohibitively costly and can limit backward-compatibility. To date, no one has designed a computer system to transmit more than eight bits of information on an eight-bit serial bus [column 3, lines 49-54].

5. Claims 10, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach U.S. Patent No. 5,898,783 as applied to claims 1, 17 and 33 above, and further in view of Eber et al U.S. Patent No. 6,595,414 B1.

As to claims 10, 26 and 42, Rohrbach teaches that the SIM includes an interface circuit that interfaces with the WCD, as discussed above.

Rohrbach does not teach that the interface circuit includes a clock input to the removable user identity module [column 8, lines 14-36]. Rohrbach does not teach that terminating power to the SIM includes terminating power after terminating a clock signal to the clock input [column 8, lines 14-36].

Art Unit: 2131

Eber et al teaches that the interface circuit that includes a clock input. Eber et al teaches terminating power includes terminating power after terminating a clock signal to the clock input.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach so that the interface circuit would have included a clock input to the removable user identity module. Power would have been terminated to the SIM and included terminating power after terminating a clock signal to the clock input.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach by the teaching of Eber et al because it limits the range over which communication is possible between the known data carrier and a write/read station adapted to cooperate with this data carrier [column 2, lines 1-24].

6. Claims 14, 15, 30, 31, 46, 47, 54, 55, 62, 63, 70 and 71 rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach U.S. Patent No. 5,898,783 as applied to claims 1, 17, 33, 49, 57 and 65 above, and further in view of Timonen et al U.S. Patent No. 6,741,848 B2.

As to claims 54, 55, 62, 63, 70 and 71, Rohrbach teaches that the user access code is a personal identification number (PIN), as discussed above. Rohrbach teaches that the SIM is one of a removable user identification module (R-UIM) and a GSM SIM, as discussed above.

Rohrbach does not teach that the SIM is a universal subscriber identification module (USIM).

Timonen et al teaches a SIM that is a universal subscriber identification module (USIM) [column 16, lines 14-23].

Art Unit: 2131

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach so that the SIM would have been replaced by a universal identification module (USIM).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rohrbach by the teaching of Timonen et al because it can be used for user identification and interoperability between mobile communications systems and the GSM system [column 16, lines 14-23].

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
November 30, 2004

G. Toise
EXAMINER
FRONT EXAMINER
11/16 2136